

## **REMARKS**

The Applicant respectfully requests reconsideration in view of the following remarks and amendments. Claims 1-5, 7-9, and 11 were amended. Claims 6 and 10 have been cancelled. No claims have been added. Accordingly, claims 1-5, 7-9 and 11 are pending in the application.

### **I. Objections to the Claims**

The Examiner has objected to claims 6, 7, 10 and 11 for informalities. Claims 6 and 10 have been cancelled. Claims 7 and 11 have been amended such that they no longer depend from other multiple dependent claims. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the objection of claims 7 and 11.

The Examiner has objected to claims 3, 5 and 9 for informalities. Claims 3, 5 and 9 have been amended to properly form Markush claims. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the objection of claims 3, 5 and 9.

### **II. Claims Rejected Under 35 U.S.C. § 102**

Claims 1-5, 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,853,327 issued to Gilboa (hereinafter "Gilboa").

To anticipate a claim, a single reference must disclose each element of that claim. Thus, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Also, "[t]he elements must be arranged as required by the claim." *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) and MPEP § 2131.

In regard to claim 1, this claim has been amended to include "wherein the element has its own address for reception of said information." This amendment is supported, for example, by claim 6. The Applicants believe that Gilboa does not disclose this element of amended claim 1.

Gilboa discloses a game board comprising a plurality of toy figures selectably **positionable by the player** with respect to the game board. Further, Gilboa discloses an apparatus for automatic, non-discrete **sensing of the location of the toy figures** relative to the game board and actuating an audio/visual display sequence in response thereto. Thus, in Gilboa the player manipulates the toy figures and an audio/visual display sequence is activated in response to this manipulation by the player. Specifically, Figure 20 of Gilboa discloses a spring

to move the “basketball player.” However, it is not disclosed that the spring can be controlled by the game through wireless transmission. Thus, the person skilled in the art would expect that the “basketball player” is directly controlled by the player. Gilboa emphasizes the use of a spring to move the “basketball player” through direct player interaction. If the toy figure were controlled by the game, Gilboa would have disclosed an electromagnet or the like that is not mentioned by Gilboa. Therefore, the person skilled in the art would not be encouraged to automate the basketball player so that it is controlled by the game through wireless transmission because it is an essential element of Gilboa to manipulate the figures through direct player interaction. In contrast, claim 1 discloses the game controlling the position of the game piece(s) to, for example, switch on a LED light.

Moreover, in another embodiment of Gilboa the toy pieces are not moveable. For example, in Figure 19, it is not disclosed that the game element (Doll 1200) is a positionable element. The Doll acts as an “audio/visual display sequence” and not as a “toy figure selectably positionable by the player.” Thus, the Doll is not moveable and cannot be moved by the player or by the game. Consequently, Gilboa fails to disclose a positionable game piece that can be controlled by the game.

Furthermore Gilboa fails to disclose that the toy figures have their own address for reception of information sent by the game. Without such an address, individual wireless control of the elements would have been difficult to realize. Thus, Gilboa fails to teach toy figures having their own address for reception of information sent by the game.

Based on the preceding arguments, Gilboa does not teach or suggest each element of claim 1. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of this claim.

Claim 8 has been amended to include elements analogous to those of claim 1. The Examiner argued that these limitations are taught by Gilboa. For at least the reasons discussed above in the Applicants’ argument over the 35 U.S.C. § 102(e) rejection of claim 1, the Applicants submit that Gilboa does not disclose these elements of claim 8. Thus, Gilboa does not teach each element of claim 8. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of this claim.

Claims 2-5 and 9 depend from independent claims 1 and 8, respectively, and incorporate the limitations thereof. Thus, at least for the reasons discussed above in regard to the

independent claims 1 and 8, Gilboa does not disclose each element of the dependent claims. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection of these claims.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-5, 8 and 9, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

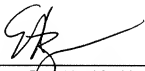
If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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10/13/08  
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